

REMARKS

The present amendment is submitted in conjunction with a Request for Continued Examination and in response to the final Office Action dated January 22, 2009, which set a three-month period for response, making a response due by April 22, 2009.

Claims 1-24 are pending in this application.

In the final Office Action, claims 1-4, 6-18, 21, 22 and 24 were rejected under 35 U.S.C. 103(a) as being unpatentable over US PG Pub 2003/0191544 to Faulhammer in view of US PG Pub 2003/0186670 to Sorrells et al. Claim 5 was rejected under 35 U.S.C. 103(a) as being unpatentable over Faulhammer and Sorrells and further in view of U.S. Patent No. 5,678,030 to Sferazza et al. Claim 19 was rejected under 35 U.S.C. 103(a) as being unpatentable over Faulhammer et al and Sorrells et al and further in view of U.S. Patent No. 3,851,742 to Sommer et al. Claim 20 was rejected under 35 U.S.C. 103(a) as being unpatentable over Faulhammer et al and Sorrells and further in view of U.S. Patent No. 5,792,483 to Siegrist et al. Claim 23 was rejected under 35 U.S.C. 103(a) as being unpatentable over Faulhammer and Sorrells and further in view of U.S. PG Pub 2001/0018872 to Tokiwa.

The Applicant respectfully disagrees again that the combination of the Faulhammer and Sorrells references renders obvious the subject matter of independent claims 1 and 24 as previously amended. In the final rejection, the Examiner argues that Sorrells teaches “converting a pulse train into a frequency

modulated signal, which is parameterized by its frequency or number of pulses".

However, the Examiner does not cite to a specific portion of the Sorrells reference where this is disclosed. The Applicants therefore respectfully request a specific citation in Sorrells that supports the Examiner's position.

Furthermore, claims 1 and 24 require that "the **circuit** is configured to be parameterized with regard to a **number of pulses per rotation ($n/2\pi$)** AND an assignment to one of the at least two virtual leading axles (a; b). However, neither Sorrells nor Faulhammer teaches configuring a circuit to be parameterized with regard to a number of pulses per rotation. The Examiner merely argues that it would be obvious to parameterize it "with regard to a number of pulses per rotation so that the control of a later drive can easily process the data".

The Applicants respectfully submit that this analysis constitutes impermissible hindsight. When prior art references require selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. **ACS Hosp Sys, Inc., v. Montefiore Hosp.**, 221 USPQ 929, 932, 933 (Fed. Cir. 1984).

Moreover, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestions supporting the combination. Under Section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. The prior art of record fails to provide any such suggestion or incentive.

ACS Hosp. Sys., Inc. v. Montefiore Hosp., 221 USPQ 929, 932, 933 (Fed. Cir. 1984).

Both Faulhammer and Sorrells are completely silent regarding parameterizing with regard to a number of pulses per rotation, so that practitioner would not be led to modify the primary reference to Faulhammer as proposed without some knowledge of the present invention.

Furthermore, neither reference remotely suggests providing at least two virtual leading axels. While the Examiner argues that this constitutes only an unpatentable “duplication of parts”, the second virtual axel is not provided merely in the event the first virtual axel fails, that is only as a back-up, duplicative part, as the Examiner argues. Rather, the second virtual axel used with the first virtual axle assures markedly improved accuracy as described in detail in the specification. Claims 1 and 24 have been amended to clarify this point.

The application as amended is believed to be in condition for allowance. Action to this end is courteously solicited. Should the Examiner have any further comments or suggestions, the undersigned would very much welcome a telephone call in order to discuss appropriate claim language that will place the application into condition for allowance.

Respectfully submitted,
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